

REMARKS/ARGUMENTS

In the Final Office Action mailed on December 10, 2010, claims 1-11, 14 and 16-23 were rejected. However, Applicants hereby request reconsideration of the application in view of the below-provided remarks.

Withdrawal of Finality

Applicants respectfully note that the present Office Action does not provide an answer to all of Applicants' substantive arguments from Applicants' previous response. The MPEP requires that, in response to Applicants' traversal of the rejection, the examiner should take note of Applicants' argument and answer the substance of it. MPEP 707.7(f).

Specifically, Applicants argue in Applicants' previous response that "the proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the principle of operation of Novis." (See pages 5 and 6 of Applicants' previous response). In addition, Applicants argue in Applicants' previous response that "the proposed modification of Novis in view of Sakashita, and further in view of Blanke would render Novis unsatisfactory for its intended purpose." (See pages 6 and 7 of Applicants' previous response.) Furthermore, Applicants argue in Applicants' previous response that "the proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the function of the portable electronic device (10) or (28) of Novis, and thus is not obvious to do so." (See pages 7 and 8 of Applicants' previous response.)

Although the present Office Action on pages 2 and 3 appears to acknowledge Applicants' arguments, the present Office Action fails to provide any rebuttal to the substantive arguments. Therefore, Applicants repeat the substantive arguments herein and request that the examiner provide answers to the arguments. Therefore, given that the present Office Action does not answer all of the substantive arguments from Applicants' previous response, Applicants respectfully submit that the finality of the present Office Action is premature. Accordingly, Applicants respectfully request that the finality of the present Office Action be withdrawn.

Claim Rejections under 35 U.S.C. 103

Claims 1, 2, 4, 9, 10, 16, 17 and 19-23 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Novis et al. (U.S. Pat. No. 5,867,795, hereinafter “Novis”) in view of Sakashita (U.S. Pat. No. 5,971,437A), and further in view of Blanke et al. (U.S. Pat. Pub. No. 2001/0046850 A1, hereinafter “Blanke”). Claim 3 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Novis in view of Sakashita, further in view of Blanke, and further in view of Amtmann et al. (PCT Pat. Pub. No. WO 00/45328, hereinafter “Amtmann”). Claim 5 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Novis in view of Sakashita, further in view of Blanke, and further in view of Page et al. (U.S. Pat. No. 6,801,787, hereinafter “Page”). Claims 6-8 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Novis in view of Sakashita, further in view of Blanke, and further in view of Raith (U.S. Pat. No. 6,510,515). Claim 11 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Novis in view of Sakashita, further in view of Blanke, and further in view of Fries (U.S. Pat. No. 6,367,701). Claim 14 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Novis in view of Sakashita, further in view of Blanke, and further in view of Benson (U.S. Pat. No. 6,292,561). Claim 18 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Novis in view of Sakashita, further in view of Blanke, and further in view of Yamada (U.S. Pat. No. 6,349,824 B1). However, Applicants respectfully submit that the pending claims are patentable over the cited references for the reasons provided below.

Independent Claim 1

Claim 1 recites:

“A processing device for the processing of an information signal, the device having a housing and having, first communication means disposed within the housing for receiving and/or transmitting the information signal, and having processing means for the processing of the information signal received and/or transmitted, and having second communication means disposed within the housing for the contactless retrieval of control information stored in a data carrier, wherein the data carrier is a SIM card, wherein the data carrier is disposed completely outside of the housing of the processing device and is adhesively attached to the housing of the processing device, and wherein

the data carrier is configured to communicate wirelessly with the second communication means through a wall of the housing of the processing device, in which the processing of the information signal by the processing means can be influenced with the aid of the retrieved control information.”

The Final Office Action recognizes that the combination of Novis and Sakashita does not teach the limitation “*the data carrier is a SIM card*” of claim 1. (See page 7 of the Final Office Action). The Final Office Action suggests that Blanke teaches the above-identified limitation “*the data carrier is a SIM card*” of claim 1. (See page 7 of the Final Office Action). The Final Office Action then states that the combined teachings of Novis, Sakashita and Blanke teach all of the limitations of claim 1. (See page 7 of the Final Office Action).

However, Applicants respectfully assert Novis teaches that the smart card (18) or (34) is not a SIM card, instead of simply “not disclosing that the smart card is a SIM card” as acknowledged in page 2 of the Final Office Action.

Novis teaches that a portable electronic device (10) includes a housing (11) that has a slot (16). (See Figs. 1-3 and column 3, lines 22-45 of Novis). Novis further teaches that the slot (16) is designed to place a smart card (18) adjacent to a sensor structure (19) that is mounted in the housing (11). (See Figs. 1-3 and column 3, lines 22-45 of Novis). The Final Office Action suggests that the smart card (18) of Novis is equivalent to the “*data carrier*” of claim 1. (See page 6 of the Final Office Action). However, Applicants respectfully assert that Novis teaches that the smart card (18) is not a SIM card.

Specifically, Novis teaches that the portable electronic device (10) includes controls unit (14). (See Fig. 1 and column 3, lines 31-34 of Novis). Novis also teaches that a portable electronic device (28) includes a base component (29) and a remote unit (30). (See Fig. 4 and column 4, lines 34-38 of Novis). Novis further teaches that the portable electronic device (28) has a slot (33) to place a smart card (34). (See Fig. 4 and column 4, lines 52-55 of Novis). Additionally, Novis teaches that the portable electronic device (10) or (28) may be a conventional cellular telephone device. (See column 6, lines 10-20 of Novis).

Novis further teaches that controls (14) allow a user to choose the mode of operation of the portable electronic device (10) or (28) between a smart card

reader/transmission mode and a conventional cellular telephone mode. (See column 6, lines 10-20 of Novis). Novis also teaches that portable electronic devices (10) and (28) may be programmed to permit use as a conventional cellular telephone as a default when the smart card (18) or (34) is not physically engaged in the slot (16) or (33). (See column 6, lines 10-20 of Novis). That is, Novis teaches that the portable electronic device (10) or (28) operates as a conventional cellular telephone even without the smart card (18) or (34). Thus, Novis teaches that the smart card (18) or (34) is not a SIM card.

In addition, Applicants respectfully assert that one of ordinary skill in the art at the time the invention was made would not modify Novis in view of Sakashita, and further in view of Blanke, as suggested by the Examiner.

For example, Novis teaches that the portable electronic device (10) or (28) operates as a conventional cellular telephone without the smart card (18) or (34). Because the portable electronic device (10) or (28) operates as a conventional cellular telephone without the smart card (18) or (34), the portable electronic device (10) or (28) must already have a SIM card.

The Final Office Action on page 3 states:

“It is well known in the art that a SIM card may be referred to as a Smart card, vice and versa. Applicants’ arguments are solely based on some type of speculative assumption that because there is a disclosure in Novis that the portable electronic device operates as a conventional cellular telephone without the smart card, the portable device, concludes applicants, must already a SIM card. Nowhere is there a relevant support for such assumption. *In arguendo*, It is well known in the art that a conventional cellular telephone does not need a SIM card or smart card to communicate. For instance, a user may use a conventional cellular phone without a SIM card or smart card to make an emergency call, for example. In that instance, the user of the portable device of Novis would be able to place emergency telephone calls when the smart card is not engaged in the slot. And, when the smart card is engaged in the slot, the portable device may be used for services allowed by the smart card.”

However, there is no teaching in Novis supporting that when the portable electronic device (10) or (28) operates as a conventional cellular telephone, the conventional cellular telephone can be used to make emergency calls only. Specifically, Novis teaches that a two-way voice cellular communications transceiver (116), such as a conventional cellular telephone device, or the like, including a data input/output terminal (117), communicates with a host database (118) to transact business between portable

electronic devices (10) and (28) and the host database (118). (See column 12, lines 1-6 of Novis). That is, Novis teaches that the conventional cellular telephone device is not limited to make emergency calls only. Thus, the portable electronic device (10) or (28) must already have a SIM card when the portable electronic device (10) or (28) operates as a conventional cellular telephone without the smart card (18) or (34).

According to the modification of Novis suggested by the Examiner, the smart card (18) or (34) of the portable electronic device (10) or (28) of Novis would be replaced by a SIM card. As a result, the portable electronic device (10) or (28) of Novis would include two duplicate SIM cards for realizing same function of operating as a conventional cellular telephone. Because the modification of Novis suggested by the Examiner would modify the portable electronic device (10) or (28) of Novis to include two duplicate SIM cards, one of ordinary skill in the art at the time the invention was made would not modify Novis in view of Sakashita, and further in view of Blanke, as suggested by the Examiner.

Additionally, Applicants respectfully assert that one of ordinary skill in the art at the time the invention was made would not modify Novis in view of Sakashita, and further in view of Blanke, as suggested by the Examiner, for the following three reasons.

The proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the principle of operation of Novis.

Applicants respectfully assert that that the proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the principle of operation of Novis.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (see MPEP §2143.01 (VI)).

As described above, Novis teaches that the portable electronic device (10) or (28) may be a conventional cellular telephone device. (See column 6, lines 10-20 of Novis). Novis further teaches that controls (14) allow a user to choose the mode of operation of

the portable electronic device (10) or (28) between a smart card reader/transmission mode and a conventional cellular telephone mode. (See column 6, lines 10-20 of Novis). Novis further teaches that portable electronic devices (10) and (28) may be programmed to permit use as a conventional cellular telephone as a default when the smart card (18) or (34) is not physically engaged in the slot (16) or (33). (See column 6, lines 10-20 of Novis).

In summary, Novis teaches that the portable electronic device (10) or (28) operates as a conventional cellular telephone when the smart card (18) or (34) is not used. That is, the principle of operation of Novis involves operating the portable electronic device (10) or (28) as a conventional cellular telephone when the smart card (18) or (34) is not used.

Thus, according to the modification of Novis suggested by the Examiner, the smart card (18) or (34) of the portable electronic device (10) or (28) of Novis would be replaced by a SIM card (assuming that the existing SIM card of the portable electronic device (10) or (28) is removed). As a result, the portable electronic device (10) or (28) of Novis would use the SIM card (18) or (34) when the portable electronic device (10) or (28) operates as a conventional cellular telephone.

Therefore, the proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the principle of operation of Novis, which involves operating the portable electronic device (10) or (28) as a conventional cellular telephone when the smart card (18) or (34) is not used. Because the proposed modification would change the principle of operation of Novis, Applicants respectfully assert that a *prima facie* case of obviousness has not been established with respect to claim 1.

The proposed modification of Novis in view of Sakashita, and further in view of Blanke would render Novis unsatisfactory for its intended purpose.

Applicants respectfully assert that that the proposed modification of Novis in view of Sakashita, and further in view of Blanke would render Novis unsatisfactory for its intended purpose.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make

the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (see MPEP §2143.01(V)).

As described above, Novis teaches that the portable electronic device (10) or (28) operates as a conventional cellular telephone when the smart card (18) or (34) is not used. That is, the intended purpose of Novis is to operate the portable electronic device (10) or (28) as a conventional cellular telephone when the smart card (18) or (34) is not used.

According to the modification of Novis suggested by the Examiner, the smart card (18) or (34) of the portable electronic device (10) or (28) of Novis would be replaced by a SIM card (assuming that the existing SIM card of the portable electronic device (10) or (28) is removed). As a result, the portable electronic device (10) or (28) of Novis would use the SIM card (18) or (34) when the portable electronic device (10) or (28) operates as a conventional cellular telephone.

Therefore, the proposed modification of Novis in view of Sakashita, and further in view of Blanke would render Novis unsatisfactory for its intended purpose of operating the portable electronic device (10) or (28) as a conventional cellular telephone when the smart card (18) or (34) is not used. Because the proposed modification would render Novis unsatisfactory for its intended purpose, Applicants respectfully assert that there is no suggestion or motivation to make the proposed modification. Thus, a *prima facie* case of obviousness has not been established with respect to claim 1.

The proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the function of the portable electronic device (10) or (28) of Novis.

Applicants respectfully assert that the proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the function of the portable electronic device (10) or (28) of Novis, and thus is not obvious to do so.

As noted in MPEP §2143.02:

“A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement*

Salvage Co., 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).” (emphasis added)

As described above, Novis teaches that the portable electronic device (10) or (28) operates as a conventional cellular telephone when the smart card (18) or (34) is not used. That is, Novis teaches that the function of the portable electronic device (10) or (28) involves operating as a conventional cellular telephone when the smart card (18) or (34) is not used.

Thus, if the smart card (18) or (34) of the portable electronic device (10) or (28) of Novis is replaced by a SIM card (assuming that the existing SIM card of the portable electronic device (10) or (28) is removed), as suggested by the Examiner, the portable electronic device (10) or (28) of Novis would operate as a conventional cellular telephone when the SIM card (18) or (34) is used. As a result, the function of the portable electronic device (10) or (28) of Novis would be changed from operating as a conventional cellular telephone when the smart card (18) or (34) is not used.

Therefore, Applicants respectfully submit that the proposed modification of Novis in view of Sakashita, and further in view of Blanke would change the function of the portable electronic device (10) or (28) of Novis. Because the proposed modification would not result in elements with no change in their respective functions, the rationale set forth in the Office Action does not support a conclusion that claim 1 would have been obvious. Thus, Applicants respectfully assert that a *prima facie* case of obviousness has not been established with respect to claim 1.

Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1. As a result, Applicants respectfully assert that claim 1 is patentable over Novis in view of Sakashita, and further in view of Blanke.

Dependent Claims 2-11, 14 and 16-23

Claims 2-11, 14 and 16-23 depend from and incorporate all of the limitations of independent claim 1. Thus, Applicants respectfully assert that claims 2-11, 14 and 16-23 are allowable at least based on an allowable claim 1. Additionally, claims 21-23 are allowable for further reasons, as described below.

Dependent Claims 21-23

Claims 21-23 recite in part that “the rear wall has a recess, wherein the adhesive label is attached to the rear wall in the recess such that a surface of the adhesive label does not extend over the rear wall beyond the recess” (emphasis added). The Final Office Action suggests that Sakashita teaches the above-identified limitation of claims 21-23. (See pages 10 and 11 of the Final Office Action). However, Applicants respectfully assert that Sakashita does not teach the above-identified limitation of claims 21-23.

Sakashita teaches that a non-contact type data carrier label (20) on an object (27) includes a supporting film (23), a data carrier (25) and a releasable type adhesive layer (22) and that the data carrier (25) is held in a gap (28) formed on supporting film (23). (See column 4, line 63-column 5, line 16 and Figs. 6 and 7 of Sakashita). Sakashita further teaches that the supporting film (23) is formed in the shape of a comparatively thick rectangular body with the gap (28) formed as a rectangular recess. (See column 4, line 63-column 5, line 16 and Figs. 6 and 7 of Sakashita). That is, Sakashita teaches that the supporting film (23) has the gap (28), which is formed as a rectangular recess in the supporting film (23).

However, as shown in Figs. 6 and 7, Sakashita does not teach that the rear wall of the object (27) has any recess. Rather, Sakashita teaches that the supporting film (23) has a recess. Thus, Applicants respectfully assert that Sakashita does not teach that “the rear wall has a recess, wherein the adhesive label is attached to the rear wall in the recess such that a surface of the adhesive label does not extend over the rear wall beyond the recess” (emphasis added), as recited in claims 21-23.

The Final Office Action on page 5 states that “one of ordinary skill in the art would also find obvious that in whichever place the data carrier may be attached (on the object) can be considered a recess for the data carrier.” However, claims 21-23 recite in part that “the rear wall has a recess” (emphasis added). As described above, Figs. 6 and 7 of Sakashita clearly show that the rear wall of the object (27) does not have any recess.

As a result, a *prima facie* case of obviousness has not been established with respect to claims 21-23. Thus, claims 21-23 are patentable over Novis in view of Sakashita, and further in view of Blanke.

CONCLUSION

Generally, in this Response to Final Office Action, Applicants have not raised all possible grounds for (a) traversing the rejections of the Final Office Action or (b) patentably distinguishing any new or currently amended claims (i.e., over the cited references or otherwise). Applicants however, reserve the right to explicate and expand on any ground already raised and/or to raise other grounds for traversing and/or for distinguishing, including, without limitation, by explaining and/or distinguishing the subject matter of the Application and/or any cited reference at a later time (e.g., in the event that this Application does not proceed to issue with the current pending claims, or in the context of a continuing application). Applicants submit that nothing herein is, or should be deemed to be, a disclaimer of any rights, acquiescence in any rejection, or a waiver of any arguments that might have been raised but were not raised herein, or otherwise in the prosecution of this Application, whether as to the original claims or as to any of the new or amended claims, or otherwise. Without limiting the generality of the foregoing, Applicants reserve the right to reintroduce one or more of the original claims in original form or otherwise so as to claim the subject matter of those claims, both/either at a later time in prosecuting this Application or in the context of a continuing application.

Applicants respectfully request reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-4019** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-4019** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted on behalf of:

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